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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,678	08/20/1999	MARY K. MCCARTY	1002JJ-35352	9419

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

o Kim Cabello

Office Action Summary

Application No.

09/378,678

Applicant(s)

MCCARTY ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Applicant cancelled Claims 1-5 and 33-39, and amended Claims 6, 8, 16, and 27-29 to reflect dependency from Claim 30. Claims 6-32 are pending in this Final Office action.

Response to Arguments

Applicant's arguments filed 25 April 2003 have been fully considered but they are not persuasive.

The Applicant respectfully traverses the Examiner's position on the combination of Small in view of Borders.com. The Applicant argues there is no suggestion to combine.

This Examiner maintains the position that motivation exists to combine Borders.com with Small. Small teaches remote electronic ordering of a social expression card, gift giving, and combining a social expression card with a gift for an intended recipient, wherein the recipient redeems the gift card at a participating merchant. Small further teaches the problematical problems of gift giving and stresses convenience in the experience (please see at least col. 2, lines 1-25). This Examiner agrees with the Applicant's admission that a) store locators exist and b) selecting a merchant store that is not located near the recipient would be of little value to the recipient, and therefore firmly believes that it would be obvious to one of ordinary skill in the art of gift giving that leaving the

merchant selection up to “chance” with regard to proximity to the intended recipient is neither desirable nor perceived to be convenient. Since the instant claims pertain to a method of conducting business, it is reasonable to expect that a service implementing the system and method of Small would take a prudent course of action to solve the problem of eliminating “chance” selection by providing a merchant store locator to assist the gift giver with making a prudent merchant selection. Borders.com teaches a solution to the pertinent problem of eliminating “chance” selection of a merchant location by providing customers with a merchant and merchant store locator that helps the gift giver determine merchant proximity to the intended recipient. The teachings of Borders.com applies horizontally across gift giving services requiring similar customer convenience, and therefore the system and method of Borders.com would be recognized by the implementers of Small as providing a viable means of facilitating gift giver and recipient convenience by eliminating “chance” in the merchant location selection process, and thereby improving the probabilities of repeat business.

Drawings

1. New corrected drawings are required in this application because at least (please refer to 37 CFR 1.84 for drawing requirements):
 - Figures 5-19 do not meet margin requirements,

- Figures 4-19 contain lines, numbers, or letters not uniformly thick and well defined,
- Figures 1-19 contain numbers and reference characters not plain and legible, and
- Figures 4-19 contain legends that are poor quality.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 6-7, 10-11, 16-20, 25-27, and 29-32 are rejected under 35 USC 103(a) as being unpatentable over Small, Paper #9 patent number 5,513,117, in view of Borders.com (a collection of articles cited in Paper #9 PTO-892, page 1 of 2, Items: U-X; and page 2 of 2, Item: U).**

Small teaches a system and method for designing personalized greeting cards, selecting gifts and gift amounts from a menu, and printing and mailing the personalized greeting card and gift. Small teaches remote customers using personal computers connected to the greeting card and gift central computer via the public telephone network to preview gift card designs, select a card design for a recipient, select a gift certificate from a number of participating listed merchants, optionally personalize the combined card and gift with graphics and text, have it printed and mailed to the recipient's physical address or have it electronically mailed to the recipient, and pay electronically with a credit card (please see abstract; Fig. 4 (50, 51, 54, 64); col. 1, line 15 through col. 3, line 59; col. 5, lines 35-45; col. 6, lines 6-12). Small teaches a greeting card and gift selection combination that is printed on perforated card stock to allow easy separation of the gift certificate or pre-paid phone card from the greeting card (see at least Fig. 10 (173); Fig. 11 (180, 181); col. 7, lines 36-46). Small further teaches the customer providing recipient information to the central computer, viewing a list of occasion categories and selecting from a variety of pre-designed greeting cards with sentiments, or customizing a greeting card with a sentiment (see at least col. 7, lines 1-13).

Small teaches all the above as noted under the 103(a) rejection and further teaches listing a number of participating national merchants from which to choose a gift certificate and dollar amount, but does not specifically disclose a merchant locator. Borders.com teaches an online retail outlet for buying gift

certificates and further teaches web links to retail store locations organized by state, locality within each state, and hours of operation. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Small to list locations of national merchants as taught by Borders.com, in order to achieve customer and recipient convenience objectives and thereby retain existing customers and attract recipients to the site as potential new customers.

- 3. Claims 8-9 and 12-15 are rejected under 35 USC 103(a) as being unpatentable over Small, Paper #9 patent number 5,513,117, and Borders.com (a collection of articles cited in Paper #9 PTO-892, page 1 of 2, Items: U-X; and page 2 of 2, Item: U), as applied to Claim 30, further in view of PR Newswire (Paper #9 PTO-892, page 2 of 2, Item: V).**

Small and Borders.com teach all the above as noted under the 103(a) rejection and further teach listing national merchants, prompting the buyer to make a combined greeting card and gift selection, entering gift amount information and recipient information, but do not disclose ordering for multiple recipients. PR Newswire teaches online gift giving through Nordstrom's website at www.nordstrom.com. Built-in conveniences for customers include a multiple shipping feature that allows customers to ship their orders to different addresses across the country in a single order. Gift orders can be boxed and shipped directly to multiple recipients (\$4.00 per gift boxes) or a customer may choose to

receive their gift purchases with complimentary flat gift boxes to make personal deliveries (see page 1). PR Newswire further teaches a) customers using the online locator to find stores by state or zip code to get map directions to store locations within the selected state, b) customers registering on the site and using a personal address book to record addresses and phone numbers of friends and family, and c) taking advantage of the gift reminder service to set up personal email reminders for themselves for special dates and occasions. PR Newswire teaches registered customers accessing a complete history of their previous online purchases at any time (see pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Small and Borders.com to incorporate ordering for multiple recipients at different addresses as taught by PR Newswire, in order to accommodate group ordering of a greeting card and gift combination, and thereby further provide the buyer with additional purchasing conveniences.

- 4. Claims 21-24 are rejected under 35 USC 103(a) as being unpatentable over Small, Paper #9 patent number 5,513,117, and Borders.com (a collection of articles cited in Paper #9 PTO-892, page 1 of 2, Items: U-X; and page 2 of 2, Item: U), as applied to Claim 19, further in view of Official Notice regarding privacy expectations and mailing practices.**

Small and Borders.com teach all the above as noted under the 103(a) rejection and further teach printing the name and address of the recipient and the

sender on the card, and printing a combined card on both sides of a single sheet (Small: see at least Fig. 11 (180, 181); col. 6, lines 42-46). This examiner takes the position it would be a prudent business practice to meet privacy expectations as compared to a greeting card and gift certificated enclosed in an envelope, and thereby not simply mail the card with sentiment and gift value and other identifying information exposed due to a lack of a step in folding the card before it is mailed. This examiner further takes the position that all mailing information noted above would be printed on the opposite side of either Fig. 11 (180) or Fig. 11 (181) so that when the card is folded to conceal sentiment privacy, gift values, and PIN number, the address information would be on the outside of the folded card for postal authority use. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Small and Borders.com to include card folding as noted above, in order to maintain equivalent expectations of privacy as compared with an envelope-enclosed card and gift certificate.

5. **Claim 28 is rejected under 35 USC 103(a) as being unpatentable over Small, Paper #9 patent number 5,513,117, and Borders.com (a collection of articles cited in Paper #9 PTO-892, page 1 of 2, Items: U-X; and page 2 of 2, Item: U), as applied to Claim 30, further in view Christensen et al, patent number 5,710,886.**

Small and Borders.com teach all the above as noted under the 103(a) rejection and further teach prepaid gifts, money orders, or virtually any gift which can be evidenced by an electronically generated personalized printout, and further teach retail sales outlets selling gifts in combination with purchased greeting cards, but do not disclose coupons as a form of gift-giving. Christensen et al. teach an electronic method of distributing, generating, and redeeming discount coupons, rebate certificates, or gift certificates. Christensen et al. teach discount coupons as being an integral part of marketing strategies for many retail consumer goods, and further teach product manufacturers relying upon coupons, rebates, and gift certificates to promote new and existing products, to boost sales, and to obtain demographic information concerning consumer buying patterns. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Small and Borders.com to include coupons as taught by Christensen et al., in order to offer additional incentives provided by manufacturers associated with the retail site.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

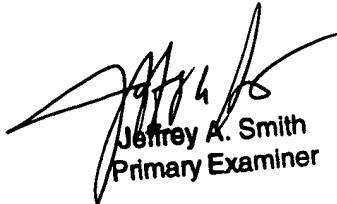
Washington D.C. 20231

or faxed to:

703-305-7687 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RMP
July 9, 2003



Jeffrey A. Smith
Primary Examiner